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10/576,414

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Kazunobu Watanabe

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03/25/2010

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

03/25/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. 10/576,414 | Applicant(s) WATANABE ET AL. | |
| | Examiner WALTER B. AUGHENBAUGH | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1 and 2 in the Amendment filed January 15, 2010 have been received and considered by Examiner.
2. The cancellation of claims 3-8 in the Amendment filed January 15, 2010 has been acknowledged by Examiner.
3. The amendments made in the abstract in the Amendment filed January 15, 2010 have been received and considered by Examiner.

REPEATED OBJECTION

4. The objection to the abstract made of record in paragraph 2 of the previous Office Action mailed September 25, 2009 has been repeated in regard to the word "eccentrically" (line 6 of abstract). The objection identified "the indefinite language identified in the 35 U.S.C. 112, second paragraph, rejection made of record below" as a basis for objection. The 35 U.S.C. 112, second paragraph, rejection stated "[t]he structure that Applicant intends to recite by "embedded eccentrically towards the bottom within inner/outer layer resin (2) making up the inner and outer layers" cannot be ascertained. Most specifically, for the purposes of the abstract, what does "eccentrically" mean? Note that "eccentrically" was deleted in claim 1 in the Amendment.

WITHDRAWN REJECTIONS

5. The 35 U.S.C. 112, second paragraph, rejection of claims 1-4 and 6-8 made of record in the previous Office Action mailed September 25, 2009 has been withdrawn due to Applicant's

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amendments made in claims 1 and 2 in the Amendment filed January 15, 2010 (and cancellation of claims 3, 4 and 6-8).

UPDATED REJECTIONS

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al. (USPN 4,816,308).

In regard to claim 1, Shimizu et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 3, and alternatively, Fig. 4. In regard to the last four lines of the claim, Shimizu et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 3 of Shimizu et al. with Applicant's Fig. 1.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al. (USPN 5,759,653).

In regard to claim 1, Collette et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 4, and alternatively, Fig. 5. In regard to the last four lines of the claim, Collette et

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al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 4 and 5 of Collette et al. with Applicant's Fig. 1.

In regard to claim 2, the recited distance of Collette et al. is 0 at the lowest point of the preform. See, for example, Fig. 4, and alternatively, Fig. 5.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604) (English abstract filed with IDS).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See English abstract text and figures. In regard to the last four lines of the claim, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See figures 3A-3D. In regard to the last four lines of the claim, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures 3A-3D with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (USPN 4,816,308).

In regard to claim 2, Shimizu et al. teach the resin mass as discussed above in regard to claim 1. While Fig. 3 in particular appears to show a distance that corresponds to the claimed distance that is close to, if not about, 10%, Shimizu et al. teach that the relative amount of the resins A and B may vary widely and that it is desirable to achieve good transparency (col. 4, lines 37-57), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the thickness of the bottom layer of resin A, such as to decrease its thickness in order to achieve the desired degree of transparency, depending on the particular desired end results, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re*

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Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). MPEP 2144.05 II.B. Since Resin B is the barrier layer, minimizing the thickness of the layers of resin A will not substantially affect the barrier properties of the container from which the resin mass is formed if at all.

Response to Arguments

13. Applicant's arguments in regard to the 35 U.S.C. 102 rejections of the claims based on Shimizu et al. (USPN 4,816,308) and Collette et al. (USPN 5,759,653) made of record in the previous Office Action have been fully considered but are not persuasive.

Applicant argues that the performs taught by Shimizu et al. and Collette et al. are "completely different". However, regardless of whether or not there are differences, the structures taught by both Shimizu et al. and Collette et al. independently read on the structure claimed by Applicant. Applicant's arguments appear to relate to how the performs are made and used, and do not appear to allege any structural differences.

14. Applicant's arguments in regard to the 35 U.S.C. 102 rejections of the claims based on Kuwabara et al. (JP 03-234604 and English abstract filed with IDS) have been fully considered but are not persuasive.

Applicant argues that Kuwabara et al. "does not indicate that the layer distribution of the intermediate resin layer of the molten resin mass is formed as recited in the present claims". However, the structure taught by Kuwabara et al. reads on the structure claimed by Applicant. It is not clear to what "layer distribution" Applicant refers, but the structure taught by Kuwabara et al. reads on the structure claimed by Applicant. Applicant also argues that the structure recited

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in the last four lines of claim 1 is not taught by Kuwabara et al. without explaining how this is so. However, as stated in the previous rejections of claim 3, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved) and compare figures 3A-3D with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /

Examiner, Art Unit 1794

3/20/10

/Rena L. Dye/

Supervisory Patent Examiner, Art Unit 1794